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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,014	12/04/2001	Chen Xing Su	10209.276	6898

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EXAMINER

OH, SIMON J

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/006,014	SU ET AL.	
	Examiner	Art Unit	
	Simon J. Oh	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Papers Received

Receipt is acknowledged of the applicant's amendment, response, petition for extension of time, and request for continued examination, all received on 14 June 2004.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 1-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moniz in view of Nair *et al.*, and Wadsworth *et al.* is withdrawn.

Claims 1-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gidlund (U.S. Patent No. 6,346,449).

The Gidlund patent teaches the use for an extract derived from the fruits, leaves, bark or roots of *Morinda citrifolia*. Fruit extracts may be either liquid, as pressed from the fruits and processed in the ways conventional to the art; or they may be processed into a powder (See Abstract; and Column 4, Lines 19-30). The liquid extract of *Morinda citrifolia* will be present in an amount ranging from 0.1 mL to 2 mL per kilogram of body weight of the patient. The dry extract of *Morinda citrifolia* will be present in an amount ranging from 5 mg to 200 mg per kilogram of body weight of the patient (See Column 5, Lines 16-23). Specific dosages will depend on factors such as age and general state of health (See Column 5, Lines 42-49). The

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medicament containing the *Morinda citrifolia* may be in various forms, including a liquid solution, emulsion, or suspension, granules, pills, capsules, and tablets, to be administered in a single daily dose or several daily doses (See Column 5, Lines 56-62).

Although the Gidlund patent is directed towards methods of treating tinnitus, it is disclosed that in other prior art, that *Morinda citrifolia* is known to be useful for other conditions, such as menstrual cramps, arthritis, gastric ulcers, sprains, injuries, and pain (See Column 2, Lines 3-19). It is the position of the examiner that one of ordinary skill in the art would be able to treat a patient for these conditions using the general guidelines disclosed in the Gidlund patent with a reasonable expectation of success. It is also the position of the examiner that the dosages ranges disclosed within the Gidlund patent read on the dosage ranges claimed in the instant application. Therefore, it is the position of the examiner that the property of selective COX-2 inhibition is inherent in the compositions disclosed in Gidlund. Thus, the instantly claimed invention is *prima facie* obvious.

Response to Arguments

The applicant's arguments, received on 14 June 2004, have been considered, but are not found to be persuasive.

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection presented above.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (571) 272-0599. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Simon J. Oh
Examiner
Art Unit 1615

sjoh


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600